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IN THE

Supreme Court of the United States

October Term 1968.

No. 1127

TECHNITROL, Inc.,

Petitioner,

vs.

HON. EDWARD J. McMANUS,

Respondent.

BRIEF AND APPENDIX IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

This brief is submitted on behalf of Collins Radio Company, defendant in the civil action from which the present proceeding arose, and deemed a respondent pursuant to Rule 21(b) of the Federal Rules of Appellate Procedure. Hereinbelow Collins will be called "Respondent."

Introduction.

There is no basis for issuance of a writ of certiorari here.

The circumstances urged by petitioner are largely fictitious and hypothetical, and in any event, as shown hereinbelow, even if the questions raised should be decided in petitioner's favor, this would not be determinative of the ultimate issue.

The essential aspect of this controversy is that petitioner is seeking to have this Court substitute its opinion and discretion for that of the Court of Appeals. Petitioner takes no issue with the Court of Appeals over its statement of the law governing writs of mandamus, as expressed in detail at A5 to A7,[1] but essentially merely urges that the Court of Appeals was wrong in its result. Petitioner treats this petition merely as an appeal.

The reasons relied upon for granting the writ (Pet'n, p. 3) are both specious and nonexistent.

As is shown below,

1. There is no decision here in conflict with that of any other Circuit.
2. There is no conflict with procedures approved by this Court.
3. There is no important question here requiring settlement by this Court.

Before going into these matters, the incomplete and possibly misleading nature of petitioner's statement of supposed facts requires restating the case.

Restatement of the Case.

This petition is the result of a frantic scramble by petitioner to localize this litigation in the Fifth Circuit rather than in the Eighth Circuit, because of an apparent

[1]Respondent adopts petitioner's scheme of citations to the record and exhibits. Pages of respondent's appendix appended hereto are designated by "RA."

belief that the Fifth Circuit affords a more favorable climate to patent owners.[1a]

a. The Original Action and Transfer to Iowa.

Notwithstanding the minimal contact of respondent Collins to Atlanta, 1,000 miles away from Collins' home base at Cedar Rapids, Iowa, and the complete absence of any contact of petitioner Technitrol to Atlanta, petitioner initially brought suit against Collins there on August 25, 1967, rather than in Iowa, where venue is unquestionable.[2]

The serious harassment and inconvenience created by this act by petitioner required Collins to move (on October 26, 1967) to transfer this action to Cedar Rapids, both under 28 U. S. C. 1406, for failure to comply with the venue requirements of 28 U.S.C. 1400(b), and under 28 U.S.C. 1404(a), for convenience and in the interest of justice. This motion was decided by Judge Smith of the Georgia District Court by the order filed February 1, 1968 (A15), by which "after full consideration of extensive affidavits and briefs filed by the opposing parties" transfer of this action was ordered from Atlanta to Cedar Rapids (A2).

There can be no question over the fact that petitioner-plaintiff had ample opportunity to and did submit a full

[1a]There is also a distinct possibility that a motive of petitioner here is to delay this action until determination of other actions on the same patent (*Technitrol, Inc., v. United States*, Ct. Cls. No. 99-64; *Technitrol, Inc., v. Control Data Corp.*, Civil Action No. 17653, D. Md.; *Technitrol, Inc., v. Honeywell, Inc.*, Civil Action No. 18317, D. Md.; *Technitrol, Inc., v. Scientific Data Systems, Inc.*, Civil Action No. 19515, D. Md.).

[2]Collins is an Iowa corporation, and its activities in connection with the subject matter of this action have occurred at Cedar Rapids with minor exceptions.

opposition to that motion in the three months before it was decided. Judge Smith commended "the thorough and energetic efforts of counsel in presenting arguments upon the questions" raised (A16).

As the Court of Appeals commented (A2), the Georgia Court listed the factors to be considered, as set out by this Court in *Gulf Oil Corp. v. Gilbert,* 330 U. S. 501, and other cases, and found "strong ties to Cedar Rapids" and but a "tenuous connection" with Atlanta (A17).

The Georgia Court also noted that the weighted case load in the Iowa district is substantially lower than in the Atlanta district, leading to the likelihood of a speedier trial in Iowa (A3, A19),[3] and specifically found

> "The proofs as to the ultimate question of infringement are much more readily accessible at Cedar Rapids for there the manufacturing took place and continues to take place. The data relating to manufacturing is found there as to the accused system and as to other systems." (A16-A17)

In contrast, as to Atlanta, he said (A17):

> "If the Delta system constitutes an infringement, then it seems apparent that numerous other systems at defendant's plant may be found to be infringing. Moreover, the Collins personnel located in Atlanta will have little if any knowledge of the facts which underlie the real issues in this case. These persons are located in Cedar Rapids."

The Georgia Court expressly found that

> "* * * the Iowa forum is much more convenient than Atlanta from the standpoint of both the subject matter of the alleged patent and a large number of obvious witnesses" (A17)

[3]This likelihood has been since diminished by petitioner's successful delaying tactics, including the present petition.

and found that Atlanta had "but slight contact with the forum chosen" (A17), also mentioning "the remoteness of this [Atlanta] forum to the issues of this case" (A18).

These factors were sufficient to require transfer; the Georgia Court specifically refrained from ruling on whether venue was proper or not, preferring to order transfer upon considerations of convenience and interest of justice. He said (A19):

> "Defendant has urged rather strongly that venue is improper under 28 U. S. C. A., Section 1406(a). **The Court does not deem it necessary to rest this transfer upon that ground** and this order should not be construed as a ruling for or against the contention as to improper venue."[4]

He explicitly followed "the better course" suggested by the authorities where venue was in doubt (e.g., *Phillips v. Baker*, 121 F. 2d 752, 9 Cir. 1941), to remit the parties to the district where there could be no doubt as to venue, that is, to Cedar Rapids, before rather than after protracted litigation (A19).

In short, the Georgia Court considered all the relevant factors[5] bearing on 28 U. S. C. 1404(a), on the basis of a full record, and exercised his discretion to order transfer to Iowa.[6]

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[4]Emphasis added throughout this brief, unless otherwise noted.

[5]Petitioner has raised and raises here no contention that the Georgia Court failed to consider any appropriate factor.

[6]Petitioner appears to contend (Pet'n, pp. 8, 9) that the Georgia Court had an incomplete record and complains that his decision came down before scheduled depositions were taken. As the Court of Appeals said (A9) this contention relates only to the improper venue issue under 28 U. S. C. 1406, and not to the convenience issue of 28 U. S. C. 1404(a). In any event, petitioner had full opportunity between the filing of the motion

b. Absence of Any Attempt at Review.

Petitioner made no effort to obtain review of that order of transfer.

Petitioner could have asked the Georgia Court for reconsideration, which it did not do. It could have sought to have the question certified for appeal under 28 U. S. C. 1292,[7] which it did not do. It could have petitioned the Fifth Circuit for a writ of mandamus, which it did not do.[7a] It could even have moved for retransfer, which

(Footnote continued)

on October 26, 1967, until the decision three months later, on January 30, 1968, to present to the Georgia Court whatever facts it wished. Contrary to petitioner's statement (Pet'n, p. 7) no request was made to the Georgia Court to hold up his decision to allow petitioner's depositions to be taken and considered. Petitioner merely tentatively notified the Court, on January 10, 1968 (three weeks after the transfer motion had been fully briefed by both parties and taken under submission by the Court), that

> "It is the *intention* of plaintiff to take depositions in the early part of February, *probably* on the 8th and 9th of February.
>
> "*If the Court has doubt* as to the proper venue in this matter, it would be appreciated if the Court would delay its decision until after the depositions have been filed and can be considered by the Court" (RA7).

The Georgia Court properly ignored this letter, since the issue of proper venue was unnecessary to the decision reached; in any event, plaintiff's statement of intention was a far cry from a request to defer decision.

[7]In the Fifth Circuit at least, this is indicated as the preferred course. Motions concerning transfer are appealable in the Fifth Circuit when certified under 28 U. S. C. 1292 (b). (*In re Humble Oil & Ref. Co.*, 306 F. 2d 567, 5 Cir. 1962; *Humble Oil & Ref. Co. v. Bell Marine Serv., Inc.*, 321 F. 2d 53, 5 Cir. 1963.)

[7a]Only the Fifth Circuit had jurisdiction to review the transfer (*Purex Corp. v. St. Louis Nat. Stockyards Co.*, 374 F. 2d 998, 1007, 7 Cir. 1967; *Preston Corp. v. Raese*, 335 F. 2d 827, 828, 4 Cir. 1964).

it did not then do. Instead, petitioner switched tracks, from Iowa back to Georgia.

Petitioner's attempted self-justification for this failure to seek review is belied both by the Court of Appeals (A4) and by petitioner's own deliberate choice of an alternative to such review, discussed in the following.

c. The Second Atlanta Action.

Petitioner, with evident deliberateness, having no doubt considered but having decided against seeking rehearing or appeal or petition for writ of mandamus or retransfer, indulged in a series of maneuvers to circumvent the Georgia Court's order: It first filed a second action (C. A. 11596) in the same Atlanta Court on February 27th, against respondent Collins and its supplier, Ex-Cell-O, and joined Delta Air Lines, Inc. (Collins' customer), as a co-defendant (Pet'n, p. 9).[8] Petitioner has conceded that this was done to "re-establish jurisdiction of the Fifth Circuit Court of Appeals" (RA3).

This second Atlanta complaint duplicated that in the present action in all essential respects (notwithstanding the inclusion of two additional "counts" based upon a far-fetched "third-party beneficiary" theory).

The Georgia Court in a later order filed June 3rd (RA5) characterized this second action as "redundant

[8]In the meantime, in the present action, respondent Collins, on February 8th, had filed an answer with counterclaims. On February 12th, Collins had also made Ex-Cell-O a party, by a third-party complaint, on a cause of action based on an agreement of indemnity by Ex-Cell-O, as a supplier to Collins. On February 23rd, Collins had amended its answer and counterclaims. No reply to the counterclaims has been made *even yet*. A motion to dismiss on that ground is now pending before the Iowa District Court together with petitioner's motion to stay that motion to dismiss to await the outcome of this proceeding.

and duplicative of the issues already present in the Iowa case. (In form, the cases may differ, but not in substance.)"

This second action forced the defendants there (including respondent Collins) to move on March 25th to dismiss, transfer or stay that second action.

d. The Motion to Retransfer to Georgia.

Only when continuation of this second "duplicative" action was threatened, and its effort to "re-establish jurisdiction of the Fifth Circuit Court of Appeals" (RA3) appeared in jeopardy, as a result of the motion for dismissal or transfer presented by the defendants there on March 25th, did petitioner reconsider its course. It switched tracks again.

Had petitioner truly wanted a review of the original transfer order by the Georgia Court, it then had opportunity to obtain such review by opposing the new motion to transfer, which involved exactly the same issues as in the original transfer. This would also have afforded opportunity to have the Georgia Court himself hear the oft-repeated (and incorrect) charges that respondent misled the Court by an "erroneous" affidavit, and that "new evidence" should have been considered, as petitioner still contends here (Pet'n, p. 8).

However, petitioner itself sought to prevent the Georgia Court from considering those matters. Instead of contesting the motion to dismiss or transfer that second action, and instead of advising the Georgia Court of petitioner's contentions that it believed the Court had been misled, and instead of bringing forward the additional evidence upon which petitioner relies so heavily even now, petitioner on April 4th moved for a stay of the proceedings before the Georgia Court, representing that it

intended to move in Iowa to retransfer back to Georgia the already once-transferred first action.[9]

Not until three weeks later, on April 25th, did petitioner file in Iowa the presently involved motion for retransfer.

Petitioner complains here, as it has done previously, that it supposedly has been deprived of a right of review of the Georgia Court's transfer order. The short answer to this is that petitioner had had such right of review, but chose not to use it. Instead of then seeking such review, whether from the Fifth Circuit or the Eighth Circuit or from the Georgia Court or the Iowa Court, it instead deliberately elected to seek "to re-establish jurisdiction of the Fifth Circuit Court of Appeals" by re-litigating in Georgia.[10] Only when driven by doubts of the correctness of its action and when faced with the prospect that the same Georgia Court would review what was in effect the same situation, did petitioner move in Iowa for retransfer, as a belated afterthought.

The Georgia Court refused to interfere with the Iowa Court's prerogative to decide petitioner's motion for retransfer, and by order entered June 3rd (RA5), stayed the second Atlanta action until resolution of the motion to retransfer, notwithstanding his "having serious doubts as to the retransfer proceed ıg" (RA5). The Georgia Court went on to indicate his course should the retransfer be denied. He said (RA5):

> "If the motion to retransfer is denied, this Court will dismiss this action as to Ex-Cell-O Cor-

[9]This makes it obvious that petitioner did not want the Georgia Court to review the matter, but wanted a second chance, before a different judge, less well acquainted with the case, who might be more favorably inclined toward petitioner's contentions.

[10]The Court of Appeals also clearly indicated its view that some review was available (A4).

> poration and Collins Radio Company as being redundant and duplicative of the issues already present in the Iowa case. (In form, the cases may differ, but not in substance)."

Also, he held that the action as to Delta Air Lines would be stayed until resolution of the Iowa litigation (RA6).[10a]

This order thus effected a practical resolution of this venue dispute, to avoid making this lawsuit a shuttlecock. Upon denial of the retransfer motion, the Atlanta proceedings will be dismissed or stayed, leaving but a single action in Iowa to try all issues raised in either action.

The motion for re-transfer was a belated attempt to get the Iowa Court to review (and overrule) the Georgia Court's decision. The pretext was supposedly "new evidence" asserted to have "misled" the Georgia Court, although, as expressly found by the Court of Appeals (A3), that evidence relates only to a phase of the matter *not decided* by the Georgia Court, namely, whether proper venue existed in Georgia under 28 U. S. C. 1400(b). That evidence does not concern the *forum non conveniens* issue on which the Georgia Court based transfer.

Before the Iowa Court, respondent Collins opposed the requested re-transfer on a number of separate grounds:

[10a]He properly found that resolution of the Iowa litigation would make unnecessary further proceedings as to Delta. Petitioner now contends that this Iowa action would not determine some issues as to Delta (Pet'n, p. 13). This is wrong, for two reasons: (1) Petitioner's counsel has stated that petitioner is accusing Collins of infringing every patent claim of which Delta is accused (Relson Aff., par. 10, RA9), so that *all* claims in controversy will be adjudged in Iowa; and (2) Delta has agreed to waive service and venue in this Iowa action and to be bound by its outcome, should the Georgia Court stay the second Georgia action as to Delta (Maurer Aff., RA8). This present action has all the issues in the Georgia case, plus more.

(1) The re-transfer was sought untimely and was an attempt indirectly to get appellate review of the Georgia Court's order of transfer, after waiver of any right to such review;

(2) The motion was beyond the authority of the Iowa Court to grant, because

(a) it sought to have one District Court exercise appellate review over another, and

(b) re-transfer would be contrary to 28 U. S. C. 1404(a), because the action could not have been brought in Atlanta, venue there being improper under 28 U. S. C. 1400(b).[11]

(3) If within the Court's authority, re-transfer would be discretionary and the Court should not exercise its discretion here,

(a) on principles of comity and "law of the case";

(b) because there was no relevant "new evidence" nor any deception of the Georgia Court as intemperately charged by petitioner, and petitioner's assertions at best were directed to propriety of venue under 28 U. S. C. 1400 (b), and not to the issue of transfer under 28 U. S. C. 1404(a); and

(c) because the Georgia Court was correct, and the convenience of parties and witnesses and the interest of justice dictate that the Iowa Court is the proper forum.

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[11]A District Court has no power to transfer to a district where the action could not have been properly brought originally (*Hoffman v. Blaski*, 363 U. S. 333). This issue of proper venue in Atlanta has not been passed on in this case, and still remains in contention. No issue exists here over propriety of venue in Cedar Rapids.

The Iowa Court (by Chief Judge McManus) found it unnecessary to decide all these issues. His order of August 14th (A12) was based explicitly upon points 2(a) and 3(a) and implicitly upon point 3(b).[11a] He said (A14):

> "It is the view of the court that to entertain such a determination would be tantamount to reviewing [Georgia] Judge Smith's order of February 1, 1968, thus constituting a usurpation of appellate function and interference with orderly judicial process" (citing cases).

e. The Petition for Writ of Mandamus.

Petitioner then filed a petition with the Court of Appeals for the Eighth Circuit for a writ of mandamus (RA1), purportedly seeking review of the Iowa Court's discretionary order of August 14, denying re-transfer.

It becomes obvious from that mandamus petition that directing it to the Order of August 14th was simply a ruse with an ulterior purpose, to obtain a much belated review of the Georgia Court's initial transfer order. Thus, at pages 1 to 3 (RA1-3), under the heading "Summary of Petitioner's Position," there is not a single error or abuse ascribed to Judge McManus. The "key facts" alluded to refer entirely to petitioner's contentions regarding action by the Georgia Court, and not by the Iowa Court (RA1-2).

The "Issues Presented" at page 13 of that petition (RA3) exposed petitioner's true objective—that is, merely to have the Court of Appeals substitute its judgment for the discretion exercised by the Georgia Court, in

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[11a]It would follow that, should there be a remand, the Iowa Court would need to decide the remaining issues, and might well again decline retransfer on different grounds.

finding that the convenience of parties and witnesses and the interest of justice require trial in Iowa rather than Georgia. The second "Issue Presented" expressly raised the question whether the Court of Appeals should review the merits of the *Georgia* Order (RA3), and the second branch of the mandamus petition (at RA1) affirmatively sought an order from the Court of Appeals compelling re-transfer.

It was thus clear that that mandamus petition was essentially merely an attempt at a belated appeal from the Georgia Court's original order of transfer, to have the Court of Appeals *ab initio* make a discretionary judgment on a number of aspects of the situation which the Iowa Court found unnecessary to pass upon.

f. The Decision on the Mandamus Petition.

The Court of Appeals denied the petition for writ of mandamus. As to review of the Georgia Court's original transfer order, the Court of Appeals found unreasonable delay in petitioner's invoking its jurisdiction, and said (A4):

> "Such an unreasonable delay standing alone is a sufficient basis for our refusal to exercise our discretionary power to entertain the writ * * *."

Although petitioner here protests that the delay was not unreasonable, and attempts to explain it away,[12] it

[12]Petitioner asserts (A25-A26) that the more than 7-month delay was justified because of intervening discovery proceedings, which assertedly uncovered a basis for such review in the form of supposedly new evidence. This assertion flies in the face of the facts: (a) Petitioner sought to "re-establish the jurisdiction of the Fifth Circuit" by filing its new complaint on Feb. 27th, less than 4 weeks after the transfer order of Feb. 1st, so that by then it presumably believed it had sufficient basis for venue in Atlanta; and (b) Petitioner told the Georgia Court on April 4th

does not appear that petitioner is here seeking review of that part of the holding by the Court of Appeals. In particular there is no contention here that the Court of Appeals lacked authority or abused discretion in so holding.

The Court of Appeals went on to consider whether the Iowa Court's order denying re-transfer should be vacated and whether the Iowa Court should be ordered to re-transfer the case to Georgia (A4-A5).

First, the Court of Appeals carefully delineated the governing law regarding the circumstances under which a writ of mandamus may be granted (A5-A7).

The Court of Appeals confirmed in its own words the governing principles that there should not be "loose issuance of the writ," and "that the traditional restraint must be exercised by an appellate court in relation to the issuance of any writ" (A5). It reaffirmed its own prior statements that the writ may issue only "against manifest judicial arbitrariness," where "the facts and circumstances are without any basis for a judgment of discretion," and ***not*** where they are "rationally capable of providing reasons for what the district court has done," and **not** where "basis exists for judgment of discretion" (A5).

The Court of Appeals expressly relied on the prior rulings of this Court in the leading cases of *Roche v. Evaporated Milk Ass'n*, 319 U. S. 21, 26, 63 S. Ct. 938,

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(Footnote continued)

(barely two months from the transfer order), that it intended to move for retransfer, and did so on April 25th (12 weeks after transfer); the production of the document on which petitioner predicates its contention of "new evidence" was *after* both of these events, on May 8th (A26). With like dilatoriness, even after the Iowa Court refused retransfer (on August 14th), petitioner waited 33 days before petitioning for writ of mandamus (as compared with the 10 days permitted for appeal from an interlocutory order, 28 U. S. C. 1292[b]).

941, and *Will v. United States,* 389 U. S. 90, that use of the writ should be "to confine an inferior court to a lawful exercise of its prescribed jurisdiction or to compel it to exercise its authority when it is its duty to do so," and that "only exceptional circumstances amounting to a judicial 'usurpation of power' will justify invocation of this extraordinary remedy" (A6-A7).

It also pointed out this Court's ruling in the *Will* case that "the party seeking mandamus has 'the burden of showing that its right to issuance of the writ is "clear and indisputable"'" (A7).

Thus, the Court of Appeals expressly followed the principles established by this Court.

In conformity with this well-settled state of the law (which is not disputed here by petitioner), the Court of Appeals found and held:

> 1. "* * * continuation of the transfer proceedings would further unduly delay the already long delayed trial on the merits[13] and would not be in the interest of justice and would thwart the congressional policy against unreasonable delay in litigation by piecemeal appeals" (A8).
>
> 2. The ruling on the transfer order remains open for consideration on appeal from final judgment (A8).
>
> 3. The new grounds asserted before the Iowa Court in support of the requested re-transfer have little bearing on the issue of transfer under Section 1404(a); the "new evidence" bears almost wholly on whether venue exists in Georgia, and is

[13]This action has now been pending over one year and seven months *and the pleadings are not yet completed.* The reply to the counterclaims has not been filed even as yet. Hence this policy is being further thwarted by the present petition.

controverted, and there is little if any evidentiary support for petitioner's contention that new issues and new parties create any material change in the balance of convenience (A9).

4. The Iowa Court was justified in considering that the record before him was not significantly different from that before the Georgia Court, and in holding that entertaining the re-transfer motion would be tantamount to reviewing the Georgia Court's order (A9, A11).

5. The original Georgia transfer order "is a well-reasoned order which sets forth proper legal standards and sets out evidentiary support for the findings made" (A11).

6. The Iowa Court exercised proper discretion in refusing to determine the same issue previously fully considered and resolved by the Georgia Court upon substantially the same record (A11).

7. Petitioner did not meet its "heavy burden" of establishing that its right to issuance of the writ of mandamus is "clear and indisputable" (A11).

8. The Court of Appeals' own "large discretion" should be exercised to deny the writ of mandamus (A11).

On these grounds, the Court of Appeals denied the petition for writ of mandamus.

With this more complete statement of the case, we turn to the argument.

ARGUMENT.

A. The "Questions Presented" (Pet'n pp. 3-4).

We first consider the Questions Presented For Review (Pet'n, pp. 3-4) and show that all four are improper. They (a) cloak disputed contentions as fact, (b) omit pertinent and controlling additional facts, (c) seek to have this Court act as a mere court of appeals to find error in the District Court's exercise of discretion, (d) seek to have this Court substitute its discretion for that of the lower courts, or (e) ask this Court to rule academically on points which could not affect the ultimate result.

Question 1

Question 1 is actually not this case. It raises the issue of whether the Court of Appeals here had a duty to review the *Georgia* Court's order, and assumes that the Georgia order was not reviewed. There was no finding or holding below that such duty was non-existent, and in fact, the Court of Appeals *did* review that order, notwithstanding its ruling on petitioner's unreasonable delay in seeking such review. At A11 it said

> "It appears to us that Judge Smith's order is a well-reasoned order which sets forth proven legal standards and sets forth evidentiary support from the findings made."

This Question 1 also assumes as a fact what the Court of Appeals rejected; that Court expressly repudiated petitioner's contention that petitioner was precluded from obtaining reconsideration by the Georgia Court or review by the Fifth Circuit (see A3-A4).

It furthermore conveniently omits to mention petitioner's unreasonable delay in bringing the mandamus

petition, which was an important factor in the decision by the Court of Appeals (A4, A8).

Question 1 should not be considered here.

Question 2

Question 2 is also not properly in this case. It seeks to have this Court find that the Iowa Court was in error, thereby relegating this Court to the province of an ordinary appellate court; such is not this Court's function.

> "[T]he writ cannot be used 'to actually control the decision of the trial court.' *Bankers Life & Cas. Co. v. Holland,* 346 U. S. 379, 383, 74 S. Ct. 145 (1953)." *Platt v. Minn. Mining & Mfg. Co.,* 376 U. S. 240, 245, 84 S. Ct. 769 (1964).

Just as in Question 1, Question 2 assumes petitioner was precluded from review in the Georgia order, directly contrary to the Court of Appeals holding at A3-A4.

Question 2 is hence also improper here.

Question 3

Question 3 charges the Iowa District Court with abuse of discretion (which petitioner *did not even contend* before the Court of Appeals: see the petition for writ of mandamus filed Sept. 17, 1968, which ***nowhere*** accuses Judge McManus of any abuse of discretion).[14] This question merely invites this Court to disagree with and to substitute its discretionary judgment for that of the Court of Appeals.

This also is not the function of this Court. As Mr. Justice Harlan said in his concurring opinion in *Platt v. Minn. Mining & Mfg. Co.,* 376 U. S. 240, 245 (1964), "such

[14]For convenience, the Statement of Issues Presented and Relief Sought by that Petition are reproduced below at RA3-4.

a course inescapably contravenes accepted principles governing the exercise of appellate jurisdiction."

This question should not be considered.

Question 4

Question 4 is directed merely to one incidental factor in this case, concerning the sufficiency of availability of review on appeal as a ground for refusing mandamus. As is clear from the opinion below (A8), this was not taken by itself as sufficient basis for denial here of the writ of mandamus, although under this Court's holding in *Bankers Life & Cas. Co. v. Holland,* 346 U. S. 379, 74 S. Ct. 145 (1953), it could well have been. This question is also not dispositive of this case, but is at most an incidental issue.

It also should be rejected.

B. There Are No Reasons Justifying Issuance of a Writ Here.

1. The petition is unnecessary since petitioner has a remedy by appeal.

The Court of Appeals here held

> "The ruling on the transfer order, as is the situation with interlocutory orders generally, remains open for consideration upon appeal from final judgment" (A8).

This is not disputed by petitioner, but petitioner pleads that venue should be determined before, not after, trial, because any inconvenience because of which it seeks relief will already have occurred by the time trial is held.

This Court has already expressly held such a ground insufficient for a writ of certiorari or mandamus. In *Ex*

parte Fahey, 332 U. S. 258 at 259-60 (1947), this Court said:

> "Mandamus, prohibition and injunction against judges are drastic and extraordinary remedies.
>
> * * *
>
> These remedies should be resorted to only where appeal is a clearly inadequate remedy. We are unwilling to utilize them as substitutes for appeal. As extraordinary remedies, they are reserved for really extraordinary causes."

In *Bankers Life & Cas. Co. v. Holland*, 346 U. S. 379, this Court faced a situation where the District Court had severed and transferred an action as to one defendant of a large group. A petition to the Court of Appeals for writ of mandamus, to compel vacating and setting aside of the order of severance and transfer, was denied. On certiorari, this Court affirmed, notwithstanding that petitioner there (as here) urged that there would be needless expense, hardship and judicial inconvenience if the severed case were tried and only thereafter, on appeal from final judgment, were the order then reversed. There, as here, if the transfer were incorrectly ordered, the inconvenience and expense of a trial would have been incurred. This *Bankers Life* case additionally had the added factor that the ordered severance would greatly aggravate the difficulties and expense of trial. Nevertheless, this Court specifically stated, in rejecting that as a basis for review (p. 383):

> "But it is established that the extraordinary writs cannot be used as substitutes for appeals, *Ex parte Fahey*, 332 U. S. 258, 260, 67 S. Ct. 1558 (1947), ***even though hardship may result from delay and perhaps unnecessary trial***, *United States Alkali Export Asso. v. United States*, 325 U. S. 196. 202, 203, 65 S. Ct. 1120 (1945); *Roche v. Evaporated Milk Asso., supra* (319 U. S. at 31); and whatever may be done without the writ may not be done with it. *Ex parte Rowland*, 104 U. S. 604, 617 (1882). We may assume that, as petitioner contends, the order of transfer defeats the objective of trying related

> issues in a single action and will give rise to a myriad of legal and practical problems as well as inconvenience to both courts; but Congress must have contemplated those conditions in providing that only final judgments are reviewable."

Thus, in that far more aggravated *Bankers Life* case, this Court held that a writ of mandamus to review a transfer was not available merely because of expense or hardship. That decision is directly in point and controlling here.

The more recent decision in *Hoffman v. Blaski,* 363 U. S. 335 (1960), on which petitioner relies heavily here, does not affect this result. There, *the jurisdiction* of the District Court was assailed, by a petition for writ of mandamus in the Seventh Circuit Court of Appeals seeking to vacate a denial by the District Court of transfer to another district. This Court affirmed the issuance of the writ, finding **as a matter of law** that under the statute the District Court did not have jurisdiction, and hence denial of transfer was contrary to the statute and improper.

Petitioner misreads *Hoffman v. Blaski* as authorizing a writ of mandamus in every instance of denial of transfer. *Bankers Life* and its principles were not overruled, and control here.

Here, no question has been raised over the District Court's authority or jurisdiction; petitioner only contends that the Court's exercise of discretion, pursuant to conceded authority, was wrong. The present case falls squarely under *Bankers Life,* and not *Hoffman v. Blaski,* and the Court of Appeals was right in not granting a writ of mandamus.

2. *There is no conflict with another circuit* (Pet'n, p. 20).

As to its point 1 (Pet'n, p. 20), petitioner contends first that the Court of Appeals held that the transferee court (the Iowa Court) should not, *as a matter of law,*

review on the merits the Georgia Court's order of transfer. There was no such holding.

The Court of Appeals first held that petitioner was guilty of unreasonable delay (A4, A8).

It went on to hold (A8-A9) that there was no basis for the motion for re-transfer: petitioner's ground 1 ("new evidence") had little bearing on the issue of transfer here; ground 2 (new issues because of the amended counterclaim and new parties) did not change the balance of convenience; and ground 3 (consolidation to include Delta) afforded no justification where petitioner could have joined Delta originally, rather than many months later. The Court of Appeals approved Judge McManus' implied determination that the record before him was not significantly different from that before Judge Smith (A9).

Directly contrary to the statement in Petitioner's Point 1, the Court of Appeals expressly recognized that Judge McManus *had the power* to review the transfer order; this was done in quoting approvingly the *Gulf Research* case (A9-A10). There was no holding by the Court of Appeals "as a matter of law" that Judge McManus should *not* review Judge Smith's order, as petitioner states (Pet'n, p. 20); rather, the Court of Appeals expressly found that Judge McManus exercised his discretion, and did so properly; the Court of Appeals said (A11):

> "It is our view that Judge McManus was justified in exercising his discretion by refusing to redetermine the same issue which had been fully considered and resolved by Judge Smith upon substantially the same record."

Hence there was no holding that the Iowa Court, as a matter of law, could not decide the retransfer motion.

Petitioner's Point 1 (Pet'n, p. 20) is also wrong in urging that the Court below rendered a decision in conflict with decisions of the Second Circuit. The Court of Appeals here *expressly refused* to so rule. The Court of

Appeals here did *not* decide that it lacked authority to review the Georgia Court's order, although it expressed "grave doubt." Petitioner gave an incomplete quotation here. Following the passage quoted by petitioner at page 20, the Court said (A4):

> "While we have grave doubt whether we have any right to review the validity of a transfer order made by a Federal District Court outside the circuit, *we deem it unnecessary to resolve such question here.*"

The Court went on to deny the writ of mandamus here on grounds entirely separate from the question of right of review, i. e., unreasonable delay by petitioner and not only complete absence of any abuse of discretion, but a fully justified exercise of discretion, by Judge McManus.

Accordingly, Petitioner's Point 2 also is fictitious. Moreover, it would not be dispositive of this case even if accepted by this Court.

3. *There is no important question requiring resolution by this Court* (Pet'n, p. 24).

Petitioner's Point 2 has no more foundation than Point 1, and is at least equally fictitious.

At page 24, petitioner repeats its misstatement of the Court of Appeals decision; as already shown, that Court did NOT hold that a Section 1404(a) transfer order should not be reviewed by the transferee Court, or by itself on mandamus petition. Rather, it approved Judge McManus' exercise of his discretion, under the facts here, and additionally exercised its own discretion, under the facts here, to refrain from ordering retransfer (A11).

Nor is petitioner any more accurate in stating (p. 24) that the Court below acted in conflict with procedure tacitly approved by this Court in *Hoffman v. Blaski*, 363 U. S. 335.

Hoffman (as petitioner itself says at p. 25) involved a question of *whether* the Texas Court *had the power* to transfer initially, as a matter of law and statutory construction; no issue of *discretion* was involved. Here, no question has been raised as to the Georgia Court's *power* to transfer, or the Iowa Court's *power* to deny retransfer, and the *only* issue is one of discretion.

Here the Court of Appeals did the exact opposite of "declining to review," as petitioner contends (p. 26), and expressly did review the exercise of discretion by Judge McManus, and not only found it justified but also found it in accord with the Appellate Court's own judgment of discretion (A11).

The *Hoffman* case is not in point and creates no conflict. Rather this case comes squarely under *Bankers Life,* discussed above. The principles of *Bankers Life* govern, and do not justify review of the issue of retransfer here.

Any "important question" here has already been passed upon by this Court in *Bankers Life.*

Petitioner's Point 2 thus also affords no basis for this Court's intervention.

4. *The questions presented are not dispositive.*

Moreover, this Court should not intervene for the additional reason that the questions presented are essentially moot and would not determine the present controversy.

The Court of Appeals expressly found petitioner guilty of unreasonable delay (A4, A8) and expressly found that petitioner had not established a "clear and indisputable" right to the writ it sought (A11). None of the four Questions Presented For Review (Pet'n, p. 3) bring those holdings into question, so that, regardless of what this Court might rule as to those four questions, the ultimate judgment would stand, and the matters raised are essentially moot.

In addition, as already pointed out, the Iowa Court did not pass upon a number of additional grounds for denying retransfer, so that a ruling by the Court now (rather than awaiting an appeal from a final judgment) would only serve to foster the very piece-meal approach to litigation which has been so strongly deplored.

For that reason also, the present petition should be denied.

Conclusion.

The present petition should be denied, and the writ sought should not issue, because

1. The "Questions Presented" are not fairly in this case.

2. This petition is unnecessary since petitioner has a remedy by appeal.

3. There is no conflict with another Circuit.

4. There is no important question requiring resolution by this Court.

5. This petition would not be dispositive of the issue raised.

6. In the oft-quoted words of Mr. Justice Story,

> "It is for the public interest and policy to make an end to litigation * * * 'so that' * * * suits may not be immortal, while men are mortal,* * *" (*Ocean Ins. Co. v. Fields,* 18 Fed. Cas. p. 532).

Respectfully submitted,

MORRIS RELSON,
Attorney for Respondent
Collins Radio Company.

April 7, 1969.

APPENDIX.

A. Petition for Writ of Mandamus (Excerpts).

[Technitrol, Inc. v. Hon. Edw. J. McManus, File No. 19447]

[1] Petitioner, Technitrol, Inc., (Technitrol) hereby petitions this Honorable Court for a writ of mandamus, pursuant to 28 U. S. C. Sec. 1651 and Rule 21 of the Federal Rules of Appellate Procedure, directed to the Honorable Edward J. McManus, Judge of the United States District Court for the Northern District of Iowa, Cedar Rapids Division:

> (1) to vacate an order in Technitrol, Inc. v. Collins Radio Company v. Ex-Cell-O Corporation, Civil No. 68-C-5-CR, entered August 14, 1968,* (Petitioner's Exhibit **1) denying a Motion of Technitrol, Inc. to Remand or Retransfer that case to the Northern District of Georgia, Atlanta Division; and
>
> (2) to order the case transferred to the Northern District of Georgia, Atlanta Division.

I. Summary of Petitioner's Position

A. *Key Facts:* This patent-antitrust case is in an extraordinary posture because (a) the transfer (on the basis of forum non conveniens) by the Georgia court to the Iowa court was made in misplaced reliance on erroneous sworn statements in a Collins affidavit, (b) without first permitting discovery by Technitrol of the pertinent facts

*The Order of Judge Edward J. McManus is believed to be unreported.

**Hereinafter PEX.

concerning the transfer issue to counter the erroneous affidavit (later compounded by Collins causing the [2] wrongful withholding from discovery for three months of the basic agreement which showed the errors of the sworn statements), (c) the physical transfer of the case and the court records was made *without notice to Technitrol,* thus unjustly depriving Technitrol of its right to seek appellate review of the transfer order because of the resulting instant loss of jurisdiction of the Court of Appeals for the Fifth Circuit and the absence of the record required for review by that court, and (d) retransfer of this case would permit consolidation with a related action now in the Georgia court which could not be transferred to the Iowa court.

B. *Relief Sought:* The *minimum* relief sought is retransfer of this case to the Northern District of Georgia, Atlanta Division, to permit (a) full discovery of the facts concerning the transfer issue, (b) preferably an evidenciary hearing on such facts, (c) reconsideration of the original transfer order is reaffirmed, (d) appellate review on the merits by the Court of Appeals for the Fifth Circuit.

C. *Writ of Mandamus is Proper:* This extraordinary writ is proper in this case because it deals "with an issue, the convenience of parties and witnesses, 'which in its nature must be reviewed before trial, if at all.'"[1]

[3] D. *Retransfer is Procedurally Proper:* See *Hoffman v. Blaski, et al.,* 363 U. S. 333, 80 S. Ct. 1084 (1960).

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[1]*Gulf Research & Development Co. v. Leahy,* 193 F. 2d 302, 304 (3rd Cir. 1951), aff'd 344 U. S. 861 (1952). Also, see, *Pennsylvania Turnpike Commission v. Welsh,* 188 F. 2d 447, 449, footnote 2 (3rd Cir. 1951).

II. STATEMENT OF THE FACTS NECESSARY TO AN UNDERSTANDING OF THE ISSUES PRESENTED BY THE APPLICATION

A. *Chronology of Principal Events*

• • •

[8] 8. On February 27, 1968, based on discovery made subsequent to Judge Smith's transfer order and with the aim of reestablishing jurisdiction of the Fifth Circuit Court of Appeals, Technitrol filed a complaint (PEX 3-1, Exhibit 2) against Collins, Ex-Cell-O and Delta in the Northern District of Georgia, Atlanta Division, Civil Action No. 11596 (the Georgia case), charging Collins, Ex-Cell-O and Delta with infringing said United States Letters Patent No. 2,611,813, and also asserting that Technitrol is a third-party beneficiary of agreements on the part of Collins and Ex-Cell-O to hold Delta harmless against infringement of said patent by Delta.

• • •

[13] III. STATEMENT OF ISSUES PRESENTED AND RELIEF SOUGHT

A. *Issues Presented*

1. Did Judge McManus err in denying Technitrol's Motion to Remand or Retransfer on the ground that review of Judge Smith's transfer order would be a usurpation of appellate function and interference with orderly judicial powers, so that his order should be vacated?

2. In order to avoid multiple appellate review, should this court as an appellate body review the merits of Judge Smith's transfer order?

3. If this court reviews the merits should the case be retransferred to the Northern District of Georgia on the basis of the merits?

4. If this court does not review the merits, should it retransfer the case to the Northern District of Georgia in order to permit a full development of facts governing the transfer issue, reconsideration of the transfer order by Judge Smith and, if the transfer order is reaffirmed, review by the Court of Appeals for the Fifth Circuit?

B. *Relief Sought*

While Technitrol believes that Judge McManus erred in not treating the merits of the transfer issue, it believes that in order to avoid multiple appellate review this court now should (1) finally decide the transfer issue [14] on the merits and then direct Judge McManus to order retransfer of the case to the Northern District of Georgia, or (2) simply direct Judge McManus to order retransfer of the case so as to permit full development of the facts governing the transfer issue by discovery and, preferably, an evidenciary hearing, reconsideration, and review by the Court of Appeals for the Fifth Circuit if the transfer order is reaffirmed by the Georgia court.

• • •

B. Order of June 3, 1968 by Judge Smith in Second Georgia Action (PEX. 14).

ORDER ON PLAINTIFF'S MOTION TO STAY AND DEFENDANTS' MOTION TO DISMISS TRANSFER OR STAY [FILED JUNE 3, 1968]

This is an action for patent infringement in which defendants are charged with infringement of U. S. Patent No. 2,611,813, which consists of certain inventions in a Magnetic Data Storage System. In an order of January 30, 1968, this Court transferred the case of Technitrol, Inc. v. Collins Radio Co. to the Northern District of Iowa, Cedar Rapids Division. The grounds for that transfer were painstakingly set forth in that order and will not be repeated here. Ex-Cell-O Corporation has been brought into that case (now Civil Action No. 68-C-5CR, Northern District of Iowa) through a third-party complaint. Delta has not yet been brought into that litigation but has agreed to accept service in Iowa (as to Count I of the complaint in Civil Action No. 11596), will not object to venue in the Northern District of Iowa, and agrees to be bound by any judgment rendered in Civil Action No. 68-C-5CR (Northern District of Iowa, Cedar Rapids Division).

On the strength of plaintiff's assertion that a motion for re-transfer is pending in the Iowa court, this Court, though having serious doubts as to the re-transfer proceedings, will stay the proceedings herein until after the motion to retransfer is resolved. If the motion to re-transfer is denied, this Court will dismiss this action as to Ex-Cell-O Corporation and Collins Radio Company as being redundant and duplicative of the issues already present in the Iowa case. (In form, the cases may differ, but not in substance). There are other possible bases

for this decision, fully set forth in defendants' briefs, however, it is not necessary to reach these additional points.

The Court is simply not convinced by the arguments before it that the transfer of the case as against Delta would be proper, although it would obviously be desirable to have these issues tried along with the remainder of the case. At the proper time (after the motion for re-transfer is ruled upon), the Court will stay the case as against Delta. It is expected that the resolution of the Iowa litigation will render unnecessary further proceedings as to Delta, for plaintiff cannot recover from both Collins and Delta for infringement by the same equipment. See the discussion in *Aro Mfg. Co. v. Convertible Top Repl. Co.*, 377 U. S. 476 at 507-13 (1964). Defendant's counsel is directed to inform the court promptly of any action by the Iowa court regarding the transfer.

Defendants' request for attorneys fees is denied as no authority for such allowance is known to the court.

IT IS SO ORDERED.

This the 30th day of May, 1968.

SIDNEY O. SMITH, JR.
United States District Judge

C. Letter of January 10, 1968 by Plaintiff's Counsel to Judge Smith (Exh. A. to PEX. 16).

January 10, 1968

Dear Judge Smith:

There is presently pending in the above-identified case a Motion to Transfer filed by Defendants. The Motion asserts, *inter alia,* that there is improper venue.

It is the intention of Plaintiff to take depositions during the early part of February, probably on the 8th and 9th of February.

If the Court has doubt as to the proper venue in this matter, it would be appreciated if the Court would delay its decision until after the depositions have been filed and can be considered by the Court.

Respectfully submitted,

NEWTON, HOPKINS, JONES & ORMSBY
By: George M. Hopkins
Attorneys for Plaintiff

D. Affidavit of S. Maurer in Second Georgia Action (REX I-E).

Affidavit of Richard S. Maurer

RICHARD S. MAURER, being duly sworn, deposes and says as follows:

I am Senior Vice-President, General Counsel and Secretary of Delta Air Lines, Inc., the defendant named above and I have authority to make and do make the following undertakings on its behalf.

Upon entry of an order in this action, staying this action as to Delta Air Lines, Inc. or transferring it to the Northern District of Iowa, Cedar Rapids Division, Delta Air Lines, Inc. undertakes (a) to accept service of process upon it in Iowa with respect to the cause of action recited in Count I of the Complaint herein, and (b) that it will waive and not object to venue in the Northern District of Iowa, Cedar Rapids Division, and (c) that it will be bound by any judgment rendered in Civil Action No. 68-C-5CR in said district and division, to the extent such judgment may be applicable to the cause of action against Delta Air Lines, Inc. recited in Count I of the Complaint in the present action.

RICHARD S. MAURER

E. Affidavit of M. Relson in Iowa Action 68-C-5CR (REX I-H, Excerpts).

Affidavit of Morris Relson

State of New York,
County of New York, ss:

MORRIS RELSON, being duly sworn, deposes and says as follows.

1. I am a partner of the law firm of Darby and Darby, of New York City and am principal counsel for defendant Collins Radio Company in the above-entitled action. I am also principal counsel for Collins Radio Company in Civil Action No. 11596 in the Northern District of Georgia, Atlanta Division, entitled Technitrol, Inc., plaintiff, v. Ex-Cell-O Corporation, Collins Radio Company and Delta Air Lines Inc., defendants, and am familiar with the proceedings in both of these actions.

* * *

10. In discussions with Mr. Yuter concerning which patent claims plaintiff charges as being infringed, Mr. Yuter has stated categorically that Collins is accused of inducing infringement of every patent claim which may be infringed by Delta.

MORRIS RELSON

Sworn to and subscribed before me this 2 day of May, 1968.

.....
Notary Public